

REMARKS

Favorable reconsideration of this application, in light of the following discussion and in view of the present amendment, is respectfully requested.

Claim 16 is amended. Claims 1-22 are pending.

I. Rejection under 35 U.S.C. § 103

In the Office Action, at page 2, numbered paragraph 2, claims 1-22 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,128,101 to Saito in view of WO Patent No. 92/22033. This rejection is respectfully traversed because the combination of the teachings of Saito and WO '033 does not suggest:

- a mail sending unit to convert the scanned document image to an e-mail format and to send the scanned document using the e-mail to the e-mail server;
- a post-processing operation adding unit to add a post-processing operation to the e-mail to be sent;...and
- a post-processing operation implementing unit to check whether there is a post-processing operation designated in the received e-mail and to implement the post-processing operation as designated,

as recited in independent claim 1.

Saito discusses an e-mail type facsimile apparatus and reception method in which an apparatus including a transmission/reception unit 17, an encoding unit 18 which converts image data of an original document output from scanner 23 to text code for the mail, and a decoding unit 19 which converts text-coded image data to TIFF format data. Saito further discusses that communication is carried out between the e-mail type facsimile apparatus and a mail server 3.

As conceded by the Examiner, Saito fails to discuss or suggest that the e-mail type facsimile apparatus includes a post-processing operation adding unit that adds a post-processing operation to the e-mail to be sent and a post-processing operation implementing unit that checks whether there is a post-processing operation designated in the received e-mail and implements the post-processing operation as designated. The Examiner indicates that WO '033 makes up for the deficiencies in Saito, alleging that "it would have been obvious to one of ordinary skill in the art to include the post processing adding/implementing unit from [WO '033] in the e-mail facsimile machine taught in the Saito reference...to make the transfer and deletion of messages less complex and more user friendly." The Applicant respectfully disagrees.

WO '033 discusses an active messaging system in which a receiving computer system 12 receives active messages from a transmitting workstation 14. An active or passive message may be generated at workstation 14, the active message generated automatically at the workstation 14 by an active mail generator 50. At the computer system 12, the active message is received by a mail reader 60 and transmitted to an active message interpreter 70. The active message interpreter 70 of WO '033 interprets the instructions contained in the active message by converting the instructions into machine language instructions which are executed by the CPU 21.

While WO '033 does discuss that an active message may be generated at a transmitting workstation 14 by an active mail generator 50, received at a computer system 12 and interpreted by an active message interpreter 70, WO '033 does not suggest that the active mail generator 50 is a post-processing operation adding unit that adds a post-processing operation to the e-mail to be sent that has been converted from a scanned document image. WO '033 discusses that when a user wishes to send an e-mail message, an active message may be generated by the user by typing on the keyboard or may be generated automatically by the active mail generator 50. However, generating an active message is not adding a post-processing operation to an already-generated e-mail. There is no indication in WO '033 that the active mail generator 50 adds an operation to an existing e-mail. WO '033 indicates only that the active mail generator 50 generates the initial e-mail.

Further, the motivation cited by the Examiner is inadequate to suggest combining the features of Saito and WO '033. In particular, the Examiner indicates that the system of WO '033 is to be incorporated into the e-mail type facsimile apparatus "to make the transfer and deletion of messages less complex and more user friendly". However, the motivation cited by the Examiner does not indicate to one of ordinary skill in the art why the active mail generator 50 and the active message interpreter 70 of WO '033 would be incorporated into the e-mail type facsimile apparatus. There is no indication that or why the active mail generator or the active message interpreter would be used in an e-mail type facsimile apparatus and the motivation cited of making the transfer and deletion of messages less complex and more user friendly does not suggest to one of ordinary skill, why the generator or interpreter would be incorporated into an e-mail type facsimile apparatus, as typical e-mail type facsimile apparatuses do not generally include the ability to transfer and delete messages.

In addition, the teaching or suggestion to make the claimed combination must be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d

1438 (Fed. Cir. 1991). See M.P.E.P. § 2142. The present application specifically discloses that the reason the post-processing operation adding unit and post-processing operation implementing unit are incorporated into the e-mail facsimile machine is to allow a sender to delete an e-mail that is stored in a receiver e-mail server after the e-mail has been received by the receiver e-mail facsimile machine, as a typical e-mail facsimile machine is not enabled to perform post-processing. It is therefore entirely unclear how making the transfer and deletion of messages less complex and more user friendly would suggest particularly incorporating the active mail generator and the active message interpreter into an e-mail type facsimile apparatus, without referring to the Applicant's own disclosure with respect to the problem (i.e., lack of ability to delete an e-mail after reception at an e-mail facsimile machine) solved by the present invention of claim 1, for example.

Further, there is no indication that the active message interpreter 70 is able to delete messages. The active message interpreter 70 is used only to interpret instructions for processing data, etc. contained in the active message that has been sent. It is unclear as to how making the transfer and deletion of messages less complex and more user friendly would indicate why one of ordinary skill in the art would incorporate, for example, the active message interpreter 70 of WO '033 into the e-mail type facsimile apparatus of Saito. Additionally, while Saito discusses that the mail server 3 is able to transfer and delete mail, Saito does not discuss or suggest that the e-mail type facsimile apparatus 5 is able to delete mail.

Therefore, as the combination of the teachings of Saito and WO '033 does not suggest an e-mail facsimile machine including "a post-processing operation adding unit to add a post-processing operation to the e-mail to be sent;...and a post-processing operation implementing unit to check whether there is a post-processing operation designated in the received e-mail and to implement the post-processing operation as designated," as recited in independent claim 1, claim 1 patentably distinguishes over the references relied upon. Accordingly, withdrawal of the § 103(a) rejection is respectfully requested.

In addition, the combination of the teachings of Saito and WO '033 does not suggest "selecting an e-mail sending menu and inputting address information of the e-mail to be sent; selecting a post-processing operation of the e-mail to be sent; [and] inputting information needed for the selected post-processing operation," as recited in independent claim 6. Neither Saito nor WO '033 discuss inputting address information of an e-mail to be sent into an e-mail sending menu and, as discussed above, selecting a post-processing operation of the e-mail to be sent.

Therefore, claim 6 patentably distinguishes over the references relied upon, and accordingly, withdrawal of the § 103(a) rejection is respectfully requested.

Also, the combination of the teachings of Saito and WO '033 does not suggest "checking whether there is a post-processing operation designated in the received e-mail via an e-mail facsimile machine connected to the e-mail server; memorizing the post-processing operation; printing out contents of the e-mail; and implementing the memorized post-processing operation," as recited in independent claim 8. Neither Saito nor WO '033 discuss checking whether there is a post-processing operation designated in a received e-mail. Further, neither Saito nor WO '033 discuss memorizing the post-processing operation, printing out contents of the e-mail and implementing the memorized post-processing operation. Therefore, claim 8 patentably distinguishes over the references relied upon, and accordingly, withdrawal of the § 103(a) rejection is respectfully requested.

Further, the combination of the teachings of Saito and WO '033 does not suggest "a mail sending unit to scan a document to convert the document to an e-mail and to allow addition of a specific post-processing operation to the e-mail to be sent by a sender; and a mail receiving unit that receives e-mails received by the e-mail server to print out the contents of the e-mail and perform the post-processing operation," as recited in independent claim 12. Therefore, claim 12 patentably distinguishes over the references relied upon, and accordingly, withdrawal of the § 103(a) rejection is respectfully requested.

Additionally, the combination of the teachings of Saito and WO '033 does not suggest "selecting a post-processing operation of an e-mail to be sent; recording a command in response to the selection of the post-processing operation on a non-standard header of the e-mail;...incorporating the command, the scanned document, and the non-standard header;...setting a post-processing flag and storing the post-processing information via a post processing operation implementing unit; and implementing the post-processing operation by checking the post-processing flag," as recited in independent claim 19. Neither Saito nor WO '033 suggest incorporating a recorded command, a scanned document and a non-standard header in an e-mail to be sent. Therefore, claim 19 patentably distinguishes over the references relied upon, and accordingly, withdrawal of the § 103(a) rejection is respectfully requested.

Also, the combination of the teachings of Saito and WO '033 does not suggest "determining whether a post processing operation exists in a received e-mail by checking a non-standard header of an e-mail; setting a post-processing flag and storing the post-processing information; and implementing the post-processing operation by checking the post-processing

flag," as recited in independent claim 20. Therefore, claim 20 patentably distinguishes over the references relied upon, and accordingly, withdrawal of the § 103(a) rejection is respectfully requested.

The combination of the teachings of Saito and WO '033 also does not suggest "a post-processing operation implementing portion to determine whether a post processing operation is recorded on a non-standard header of a received e-mail; and a printing portion to print out contents of the e-mail received," as recited in independent claim 21. Therefore, claim 21 patentably distinguishes over the references relied upon, and accordingly, withdrawal of the § 103(a) rejection is respectfully requested.

In addition, the combination of the teachings of Saito and WO '033 does not suggest "a post-processing operation adding portion to add the specific post-processing operation to an e-mail to be sent; and a scanning portion to read a document to be sent and to create an image data," as recited independent claim 22. Therefore, claim 22 patentably distinguishes over the references relied upon, and accordingly, withdrawal of the § 103(a) rejection is respectfully requested.

Claims 2-5, 7, 9-11 and 13-18 depend either directly or indirectly from independent claims 1, 6, 8 and 12 and include all the features of their respective independent claims, plus additional features that are not discussed or suggested by the references relied upon. For example, claim 2 recites that "the post-processing operation adding unit uses a non-standard header to add the post-processing operation to the e-mail to be sent." Therefore, claims 2-5, 7, 9-11 and 13-18 patentably distinguish over the references relied upon for at least the reasons noted above. Accordingly, withdrawal of the § 103(a) rejection is respectfully requested.

II. Rejection under 35 U.S.C. § 112

In the Office Action, at page 6, numbered paragraph 3, claim 16 was rejected under 35 U.S.C. § 112, 2nd paragraph as being indefinite. Claim 16 was amended in light of the Examiner's comments, and accordingly, withdrawal of the § 112 rejection is respectfully requested.

Conclusion

In accordance with the foregoing, claim 16 has been amended. Claims 1-22 are pending and under consideration.

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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